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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,072	03/06/2001	Robert Olan Keith JR.	ABREAU-00101	5080
28960	7590	03/09/2004	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			NGUYEN, CAM LINH T	
			ART UNIT	PAPER NUMBER
			2171	11
DATE MAILED: 03/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/801,072

**Applicant(s)**

KEITH, ROBERT OLAN

**Examiner**

CamLinh Nguyen

**Art Unit**

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                         |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Double Patenting*

1. Claims 1 – 40, and 42 of this application conflict with claims 1 - 96 of Application No. 09/801,138, and claims 41, 43 – 49 of this application conflict with claims 1 – 42 of Application No. 09/799,032. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1 – 40, and 42 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 96 of copending Application No. 09/801,138. And claims 41, 43 – 49 of this application conflict with claims 1 – 42 of Application No. 09/799,032. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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The following table shows the claims in '072 that are rejected by corresponding claims in '138

Claims Comparison Table

	'072	'138
Claims	1, 36, 37, 42	1, 2, 49, 50, 73, 74
	2	4, 54, 75
	3	5, 51, 76
	4	6, 52, 77
	5	3, 53, 78
	6, 39,	7, 55, 79
	7	8, 56, 80
	8, 38,	9, 57, 81
	9	10, 58, 82
	10, 40,	11, 59, 83
	11	12, 60, 84
	12	13, 61, 85
	13	14, 62, 86
14	25 & 26	
	15	29
	16	30
	17	27
	18	28

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19	31
20	32
21	33
22	34
23	35
24	36
25	37
26	38
27	15, 16, 39, 40, 63, 64, 87, 88
28	17, 41, 65, 89
29	18, 42, 66, 90
30	19, 43, 67, 91
31	20, 44, 68, 92
32	21, 45, 69, 93
33	22, 46, 70, 94
34	23, 47, 71, 95
35	24, 48, 72, 96,

Claims comparison Table

	'072	'032
Claims	41, 43 - 49	1 - 4, 12 - 15, 23 - 25, 34 - 37

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 40, 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Witek et al (U.S. 6,253,188).

♦ As per claim 14,

Snow teaches a method of performing a research task within a searchable database comprising:

- “A searchable database” corresponds to database server (Fig. 1, element 20, col. 9, lines 53 – 55)
- “A search module” corresponds to the search engine that implemented in Fig. 1.
- “A search criteria” corresponds to arguments or selections that user enters in Fig. 7, element 112.
- “One or more matching items” corresponds to the results that sent to user (Fig. 7, element 126 – 128).
- “The search module includes keyword search” See Fig. 10, element 148, col. 29, lines 28 – 34.

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- “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, col. 31, lines 4 – 11.
- “A dichotomous key search” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
- “A parametric search” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29.

♦ As per claim 1, 27, 37,

Snow teaches a method of performing a research task within a searchable database as described in claim 14, further claims 1, 27, 37 comprising:

- “Utilizing a search module to correlate a search criteria to a searchable database for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes keyword search, hierarchical search...” See Fig. 1, 7, 10.

In particular:

- “A search module” corresponds to the search engine that implemented in Fig. 1.

- “A search criteria” corresponds to arguments or selections that user enters in Fig. 7, element 112.
- “A searchable database” corresponds to database server (Fig. 1, element 20, col. 9, lines 53 – 55)
- “One or more matching items” corresponds to the results that sent to user (Fig. 7, element 126 – 128).
- “The search module includes keyword search” See Fig. 10, element 148, col. 29, lines 28 – 34.
- “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, col. 31, lines 4 – 11.
- “A dichotomous key search” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
- “A parametric search” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29.



- “Utilizing the search module to correlate a subsequent search criteria to one or more matching items for generating one or more subsequent matching item ... search criteria” See col. 12, lines 28 – 43.

◆ As per claim 2, 15,

- “The search criteria is one or more keywords input by a user” See Fig. Fig. 10, element 148, col. 29, lines 28 – 34.

◆ As per claim 3, 16,

- “The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items” “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, 6 – 7, col. 31, lines 4 – 11.

◆ As per claims 4 – 5, 17 – 18,

- “The utilized search methodology is the dichotomous key, the search criteria is a selected one of two binary items” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
- “The utilized search methodology is the parametric search, the search criteria is one or more set parameters, and further wherein the parameters are set by a user” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29. As shown

in Fig. 10, a user can set the values for parameters such as date, the range price, or number of room.

◆ As per claim 6, 19, 31, 39,

- "The searchable database is distributed into more than one physical location"

See Fig. 1, element 20, col. 9, lines 53 – col. 10, lines 5, col. 25, lines 37 – 44.

◆ As per claim 7 – 9, 20 – 22, 28 – 30, 38,

- "The steps of utilizing the search methodologies are performed by a server" See Fig. 1, 5A, col. 25, lines 13 – 33.
- "Establishing an Internet connection with the server to utilize the search methodologies" See Fig. 5a, element 14, 24, col. 21, lines 15 – 20.

◆ As per claim 10 – 11, 23 – 24, 32 – 33, 40,

- "The searchable database is formatted in a directory tree structure" See Fig. 4, col. 18, lines 1 – 32.
- "The directory tree structure includes nodes ... branches" See fig. 4. Each category corresponds to a node. All nodes are linked together.
- "The collection of related data for a particular node is displayed in an encyclopedia like format, wherein the encyclopedia like format includes text, graphics, and links to related topics" See Fig. 8 – 10, col. 23, lines 44 – 48, col. 24, lines 10 – 16.

◆ As per claim 12 – 13, 25 – 26, 34 – 36,

- "Maintaining the node by appropriately adding and deleting data to and from the node" See col. 50, lines 4 – 15.

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- "The step of maintaining the node is performed by a node owner" See Fig. 14, col. 50, lines 4 – 15. "A node owner" corresponds to the system administrator.

♦ As per claim 42,

Claim 42 is rejected based on the rejection of claim 1, 10 – 13.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 41, 43 – 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witek et al (U.S. 6,253,188) in view of Drucker et al (U.S. 6,292,796).

♦ As per claim 41, 43 – 45, 47 – 48,

As previously noted above, Witek teaches a method for searching documents stored in a directory hierarchy structure. Witek uses a keyword, parameter, categories, and dichotomous searches methods to search for a document (See Fig.10, Witek).

The database of Witek is formatted in a tree structure (Fig. 4), comprising nodes, and related data is corresponding to each category (col. 18, lines 1 – 32.).

"Categorizing each item of data by a navigation path through the directory tree structure and by one or more parameters" see Fig. 14 – 15, Witek.

Witek does not clearly disclose the method of setting a notification signal by saving the query string, and notifying a user of new data entered into the search databases. However, Drucker et al (U.S. 6,292,796), discloses a method for searching documents in databases using keywords, category, parameters, and even allows user select options for the result such as genders (See Fig. 1, Drucker). Users can setup the query search and save as user profile to be searched (See Fig. 4, element 404, col. 7, lines 54 – 65, Drucker). The system of Drucker includes a notification module to notify users when a new data or document available (col. 7 line 54 – 59, Drucker), and display the result to users when users request (fig. 4, element 420, col. 9 line 1 – 2, Drucker).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Drucker about the notification system into the system of Witek, because the system of Drucker provides a great benefits in saving time for users (col. 1 line 56 – 58, Drucker). The combination of Drucker and Witek produces a convenience search engine for the user, where the user does not familiar with the system and does not have a lot of time for a search query.

♦ As per claim 46, 49,

- “The collection of related data for a particular node is displayed in an encyclopedia like format, wherein the encyclopedia like format includes text, graphics, and links to related topics” See Fig. 8 – 10, col. 23, lines 44 – 48, col. 24, lines 10 – 16, Witek.

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 - 49 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - Monberg et al (U.S. 6,523,021) discloses a business directory search engine.
  - Vanderpool et al (U.S. 5,781,773) discloses a method for transforming and storing data for search and display and a searching system utilized therewith.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is 305-1951. The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308- 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. A new official fax number, that will effect in December 1<sup>st</sup>, 2003, is 703 -872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Cam-Linh Nguyen  
Art Unit 2171

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER

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